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In re Application of
BORISENKO, Dmitry *et al*
Application No.: 09/807,485
PCT No.: PCT/CA99/00928
Int. Filing Date: 13 October 1999
Priority Date: 13 October 1998
Attorney Docket No.: GOW 0082 PA
For: HIGH CAPACITANCE ENERGY
STORING DEVICE

DECISION

This decision is in response to applicants' "Request for Reconsideration" ("Resp.") filed on 31 December 2000.

BACKGROUND

On 13 September 2001, a decision dismissing applicants request under 37 CFR 1.42 was mailed because the declaration signed by the legal administrator did not comply with 37 CFR 1.497(a)(4).

On 31 December 2001, applicants filed the instant response.

On 09 January 2002, applicants resubmitted the instant response via facsimile.

DISCUSSION

Applicants submitted two declarations on 16 July 2001.

One declaration included the residence and citizenship of both co-inventors and was signed by co-inventor Dmitry Borisenko on 22 June 2001. The second co-inventor, Nikolay Borisenko, was listed as deceased.

Applicants included another declaration signed by Dmitry Borisenko on 27 June 2001 as "administrator of the estate of, or executor" of the deceased co-inventor, Nikolay Borisenko. In this document, Dmitry Borisenko declared "that I verily believe the said Nikolay Borisenko to be the second inventor of the improvement in HIGH CAPACITANCE STORAGE DEVICE described and claimed in the foregoing specification."

However, the declarations were not accepted pursuant to 37 CFR 1.497(a)(4) which requires that the oath or declaration declare that "the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought."

In the instant request, applicants claim that the second declaration signed by Dmitry Borisenko as executor was "simply a mechanism for explaining why Nikolay Borisenko could not sign the original declaration," not a declaration. Resp. ¶ 5.

Applicants explain that "in the declaration, Nikolay Borisenko is listed as the second inventor for signature purposes. Thus, Nikolay Borisenko is identified as the second inventor for the purposes of the document accompanying the declaration. Identifying Nikolay Borisenko as the second inventor is not to be interpreted as meaning that another person invented the present invention before Nikolay Borisenko and his co-inventor Dmitry Borisenko. It is only for the purposes of coordinating the document with the declaration that was submitted and found in compliance with 37 CFR 1.497. The declaration and its accompanying document are meant to be read together. When read together, it is apparent that Nikolay Borisenko and Dmitry Borisenko are the original, first and joint inventors." Id. ¶ 6.

This is not persuasive.

The declaration executed on 22 June 2001 listing both co-inventors was not in compliance with 37 CFR 1.497(b). Dmitry Borisenko signed this declaration as co-inventor, not as a co-inventor and legal representative of Nikolay Borisenko. There is no indication in this declaration that Dmitry Borisenko was signing as a representative for Nikolay Borisenko, as required under 37 CFR 1.497(b). Moreover, the fact that Dmitry Borisenko subsequently executed the "Declaration by an Administrator . . ." further supports that the previously signed declaration was executed by Dmitry only in his capacity as co-inventor. Thus, an oath or declaration in compliance with 37 CFR 1.497(a) and (b), by the legal representative of the deceased inventor was still required.

The document titled "Declaration by an Administrator or Executor Attached to the Patent Application" was signed by Dmitry Borisenko as the executor of Nikolay Borisenko on 27 June 2001. The legal representative is required to state those facts that the inventor was required to state. 37 CFR 1.497(b). The facts which Dmitry Borisenko, in his capacity as legal representative, did not state are: 1) identification of the inventors (37 CFR 1.497(a)(3)), and 2) that Dmitry and Nikolay are the "original and first inventors of the subject matter for which a patent is sought. (37 CFR 1.497(a)(4)). The declaration executed by Dmitry in his capacity as legal representative states that Nikolay Borisenko is the "second" inventor, not the "first" as required under the rule and under 35 U.S.C. 115. Moreover, such a statement contradicts the previously executed declaration by Dmitry.

CONCLUSION

For the reasons discussed above, applicants request under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response, *i.e.*, an oath or declaration in compliance with 37 CFR 1.497(a) and (b), must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely respond will result in the abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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